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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/597,318	06/19/2000	Frank Venegas JR.	IDS-10505/14	4057

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EXAMINER

YIP, WINNIE S

ART UNIT

PAPER NUMBER

3637

DATE MAILED: 04/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/597,318

Applicant(s)

VENEGAS, FRANK

Examiner

Winnie Yip

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on March 1, 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is in response to applicant's amendment filed on March 1, 2005.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-7 and 15 have been cancelled. Claims 8-14 are pending in the application.

Response to Arguments

1. Applicant's argument, filed March 1, 2005, with respect to objection of "New matter" in the specification has been fully considered and is persuasive. The objection to the specification of "New Matter" has been withdrawn. Since, applicant has not discussed the references applied against the claims, upon further consideration of such subject matter, a new grounds of rejection is made based upon following references.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the feature of "a rubber-like insert" which is positioned near the open end of the sleeve (claim 14) must be shown or the feature canceled from the claim. According to the specification, the drawings only show the resilient portion (40) being a spring but not a rubber-like insert. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure

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must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

3. Claims 11-12 are objected to because of the following informalities: the recited the language "the sleeve further including an agent ..." and "... including an additive..." is improper. These features do not appear to be the structural limitations of the plastic sleeve but rather to be the component of the plastic material of the sleeve. To avoid a confusion, whether or not these "agent" and "additive" being parts of structural limitation of the sleeve must be clearly defined. For example, it could read: "wherein the plastic further including ...".

Appropriate correction is required.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 8-10 and 13-14 are provisionally rejected under the judicially created doctrine of double patenting over claims 7-10, 11 and 22 of copending Application No. 10/827,975. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: a cover comprising/consisting an elongated, generally cylindrical plastic sleeve having consistent wall, a hemispherically shaped upper end and an open lower end, and a resilient portion near the lower end in arrangement as claimed.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

6. Claims 8-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Baur (US Patent No. 5,134,828).

Baur shows and discloses a cover (18) capable for covering a post (52), the cover consisting of an elongated, generally cylindrical plastic sleeve (22) having an open lower end

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(42) and a closed hemispherically shaped upper end (24), the sleeve having an interior diameter (26) and a consistent wall thickness including the closed upper end, and a flange (28) extending outwardly from the open lower end, wherein the sleeve is made of plastic such as polyethylene (see col. 3, line 33). Baur teaches the sleeve having a wall thickness of about 0.080 to 0.1 inch and a diameter of about 3 ½ inches such that the sleeve is considered to have the interior diameter about 3 inches (see col. 3, lines 27-35) within arrange as claimed.

Claim Rejections - 35 USC § 103

7. Claims 8-9 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arth, Jr. (US Patent No. 5,299,883).

Arth, Jr. shows and discloses a protective cover assembly comprising a cover (10) for covering a post (16) extending upwardly from a ground surface, the cover (10) consisting of : an elongated, generally cylindrical plastic sleeve (18) having an open lower end and a closed hemispherically shaped upper end (20), the sleeve having an interior diameter (24) and a consistent wall thickness including the closed upper end, wherein the sleeve is made of plastic such as polyethylene (see col. 3, line 29) , a resilient portion (28) (see col. 3, line 64) being a rubber flange near the open lower end to be inserted into the interior diameter (as claims 14-15). Alternatively, Arth, Jr. teaches the protective cover assembly having a flexible resilient strap (12) which would considered as a rubber-like resilient portion inserted into and near the open lower end of the sleeve for retaining the cover over the post as claimed. Although Arth, Jr. does not specifically define the interior diameter of the sleeve having a specific range of 3 to 8 inches as claimed, Arth, Jr. teaches the cover having wall portion being dimensioned to easily slide over the post for sufficiently covering the post in very diameters. Therefore, it would have been an

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obvious matter of design choice, at the time the invention was made, to modify the sleeve of the cover of Arth, Jr. having an interior diameter in specific range of 3 to 8 inches as claimed, since the applicant has not disclosed that the sleeve the cover having specific dimension of the interior diameter solves any stated problem or is for any particular purpose, and it appears that the claimed invention would perform equally well with the sleeve of the cover provided with the specific dimension as claimed to accommodate the variety of existing different diametered post for providing the cover being easily slide over and sufficiently cover the post. Further, to create optimal dimensions for the interior diameter of the sleeve of the cover, it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617F.2d272,205 USPQ 215(CCPA 1980).

8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Arth, Jr. '883 or Baur '828 as applied to claim 8 above, and further in view of Beatty (US Patent No. 4,516,756).

The claim is considered to be met by Arth, Jr. or Baur as explained and applied in above rejections except that either Arth, Jr. or Baur does not define the cover being made of various specific plastic materials having an agent to provide a durable coloring throughout. Beatty teaches a cover (10) for covering a post, the cover being made of polymeric plastic that would be molded with desirable color pigment /agent to provide the plastic sleeve with desirable color without color painting (see col. 1, lines 62-65). Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to modify the plastic cover of Arth, Jr. being made of polymeric plastic being added with a desirable color pigment as taught by Beatty for providing a plastic cover with desirable color appearance without any painting requirement.

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9. Claims 8-9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beatty '756 in view of Arth, Jr. '883.

Beatty shows and discloses a protective cover (10) for coving an existing post (12), the cover (10) comprising an elongated, a generally cylindrical synthetic plastic sleeve (18), the plastic which could be molded with a desired color pigment to provide a durable coloring throughout (see col. 1, lines 62-65), the sleeve having an open lower end and an enclosed upper end, the sleeve having a consistent wall thickness including the enclosed upper end, and the sleeve having an interior cavity having an diameter for slidably covering the post. Although Beatty does not specifically define the interior diameter of the sleeve having a specific range of 3 to 8 inches as claimed, Arth, Jr. teaches the cover having a wall portion being dimensioned to easily slide over the post for sufficiently covering the post in very diameters. Therefore, it would have been an obvious matter of design choice, at the time the invention was made, to modify the sleeve of the cover of Betty having the interior diameter in specific range of 3 to 8 inches as claimed, since the applicant has not disclosed that the sleeve the cover having specific dimension of the interior diameter solves any stated problem or is for any particular purpose, and it appears that the claimed invention would perform equally well with the sleeve of the cover provided with the specific dimension as claimed to accommodate the variety of existing different diametered post for providing the cover being easily slide over and sufficiently cover the post. Further, to create optimal dimensions for the interior diameter of the sleeve of the cover, it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. Further, although Beatty does not define the closed upper end of the sleeve having a generally hemispherical configuration as claimed, Beatty discloses the closed end of

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the sleeve may be formed in variety of shapes corresponding to the shape of the stanchion to be received therein (see Figs. 1 and 3). And, Arth, Jr. teaches a protective cover (18) for covering an elongated stanchion (16), the cover having, as well known in the art, a closed, hemispherical shaped upper end (20) with a same shaped internal surface for increasing durability of the cover with a smooth outer surface (see col. 3, lines 43-45 and 49-51) for covering an elongated stanchion (16). Therefore, it would have been an obvious matter of design choice to a person of ordinary skill in the art, at the time the invention was made, to modify the cover of Beatty to obtain an enclosed hemispherical top end as taught by Arth, Jr. as specified in claim 8 because Applicant has not disclosed that a cover having an closed top end being formed with a hemispherical shaped dome top end provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform equally well with the either an enclosed flatten top end of Beatty or hemispherical shaped upper end as taught by Arth, Jr. because both shaped top ends perform the same function of providing a smooth protective cover with durable upper end to accommodate the shape of the stanchion for protecting a penetration of the stanchion through the sleeve with desirable aesthetic appearance.

10. Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arth, Jr. '883 or Baur '828 as applied to claim 8 above, and further in view of Bies (US Patent No. 5,503,371).

The claims are considered to meet by Arth, Jr. or Baur or Beatty as explained and applied above rejections except that neither Arth, Jr. nor Baur does not define the cover being made of

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various specific plastic materials such as polycarbonite or plastic having specific agent to provide a durable coloring throughout or having an additive with UV deterioration. However, Bies teaches a protective cover (18) for covering a post being made of any hard plastic such as high density of polyethylene (see col. 5, lines 12-16 and 25) which may have durable coloring throughout and having a ultraviolet stabilizer additive to prevent discoloration and deterioration as claimed. Therefore, it would have been obvious to one ordinary skill in the art, at the time the invention was made to modify the cover of Arth, Jr. or Baur being made of a desirable polymeric plastic such as polycarbonite having a durable color and an additive to resist discoloration and ultraviolet deterioration as an obvious matter of design choice as taught by Bies to take advantage of the polymeric plastic's desirable properties such as having sufficient impact strength characterizes, corrosion and wear properties such as thermal expansion, desirable color visual appearance for resisting of corrosion, etc. All of the foregoing is within the skills, competence and knowledge of the person with ordinary skills in the covering art, since the applicant has not disclosed that the specific type of plastic material solves any stated problem or is for any particular purpose and it appears that the claimed invention would perform equally well with the specific plastic material as claimed.

11. Claims 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Betty '756 in view of Arth, Jr. '883 as applied to claim 8 above, and further in view of Bies (US Patent No. 5,503,371) for the same reasons set fourth above rejection.

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Inquiry Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Winnie Yip whose telephone number is 571-272-6870. The examiner can normally be reached on M-F (9:30-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 571-272-6867. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Winnie Yip
Primary Examiner
Art Unit 3637

wsy
April 11, 2005